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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

0687/72242-AB/JPW/GJG

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on November 22, 2006

Signature

Typed or printed name

Gary J. Gershik

Application Number

09/981,124

Filed

October 17, 2001

First Named Inventor

Allan Green et al.

Art Unit

1638

Examiner

E. McElwain

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record.
Registration number 39,992
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Gary J. Gershik

Typed or printed name

212-278-0400

Telephone number

November 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. 72242-AB/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Allan Green et al.
Serial No.: 09/981,124 Examiner: E. McElwain
Filed : October 17, 2001 Group Art Unit: 1638
For : FATTY ACID EPOXYGENASE GENES FROM PLANTS AND USES
THEREFOR IN MODIFYING FATTY ACID METABOLISM

1185 Avenue of the Americas
New York, New York 10036
November 22, 2006

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P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to a July 12, 2005 Notice in the Official Gazette, applicants respectfully request that a panel of Examiners review the final rejection of the above-identified application which was set forth in a September 31, 2006 Final Office Action.

This Request is being filing concurrently with a Notice of Appeal in a separate paper.

1. The rejection of pending claims 26-29 and 31-43 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled has been maintained in the September 31, 2006 Final Office Action. Claims 26-29 and 31-40 are directed to transgenic plants that have been exemplified in the subject application. See, Examples in the subject application. Claims 41-43 are drawn to a process for making the transgenic plants, which process is also exemplified in the Examples of the subject application.

2. The specification provides a teaching of how to make and use the claimed transgenic plants. Specifically, to make a

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Serial No.: 09/981,124
Filed : October 17, 2001
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transgenic plant in accordance with the pending claims, the specification teaches which genes should be inserted into a plant. The specification also teaches, and the pending claims recite, the conserved amino acid sequences which the genes should encode. See, e.g. page 48, lines 1-10 of Example 3. Indeed, applicants' disclosure has been the basis for subsequent work in which transgenic plants, other than those exemplified in the subject application but within the scope of the pending claims, have successfully been made. See, applicants' January 5, 2006 Amendment, particularly pages 14-21, and the references cited therein showing such transgenic plants being made consistent with applicants' teaching.

3. The September 31, 2006 Final Office Action, however, has refused to acknowledge that the subject application enables any transgenic plant other than the exemplified plants. The refusal is justified by only four conclusory sentences on page 5 of the September 31, 2006 Final Office Action. No basis in fact is provided in the October 31, 2006 Final Office Action which directly rebuts applicants' position set forth on pages 14-21 of their January 31, 2006 Amendment.

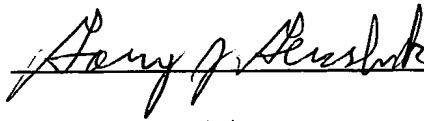
4. In conclusion, Applicants respectfully submit that the October 31, 2006 Final Office Action fails to set forth a reasoned basis founded on evidence contradicting applicants' teaching of how to make and use the claimed invention. Applicants' teaching must therefore be found to enable the claimed invention. See, e.g. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988); *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985); *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971);

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Scott v. Finney, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed. Cir. 1994); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); and M.P.E.P. § 2164.04.

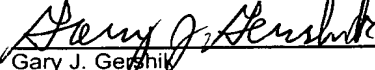
No fee is deemed necessary in connection with the filing of this Pre-Appeal Brief Request For Review. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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